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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,216	07/05/2000	Roland D. Tai	069586-0017	4737
20277	7590	04/06/2006	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/610,216	<b>Applicant(s)</b> TAI, ROLAND D.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-42,45-49,52 and 53 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 40-42,45-49,52 and 53 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 40-42, 45-49, 52 and 53 have been examined. Application 09/610,216 has a filing date 07/05/2000 and is a continuation of 09026289 (02/19/1998)

### ***Response to Amendment***

2. In response to Advisory Action filed 12/21/2005, the Applicant filed an RCE on 01/25/2006, which amended claims 40 and 47. Applicant's amendment overcame the claim objection.

### ***Claim Objections***

3. Claim 47 is objected to because of the following informalities: Claim 47 recites in line 13 "identify of the specific customer" when it should recite "identity of the specific customer". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 40 and 47 recites "identifying the promotion as a valid promotion if it has not already been presented in a completed transaction" and "plurality of promotions for the sale of a product". Nowhere, in the

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Applicant's specification is mentioned a plurality of promotions for a single product or the identifying the promotion as valid if it has not been presented in a completed transaction. The Applicant needs to point out to the Examiner where in the Applicant's specification said limitations are recited.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-42, 45-49, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,995,942) in view of Day (US 6,484,146).

As per claims 40 and 47, Smith teaches:

A system for providing promotions comprising:

a printed promotion carrier which carries information corresponding to a plurality of promotions for sale of a product (see Smith figure 6), the promotion carrier having a machine readable code thereon which identifies the promotion carrier and a respective specific customer identifier corresponding to the identified promotion carrier, the respective specific customer identifier corresponding to a specific customer pre-selected to receive the printed promotion carrier (see Smith column 5, lines 22-30; figure 6, item "barcode"), each promotion being associated with a product, each product having a

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machine readable product code (see Smith figure 6, column 5, lines 24-26; column 8, lines 1-10);

a reading device capable of reading the machine readable code and machine readable product codes, and configured to provide a data signal bearing information indicative of the identity of the promotion carrier, the identity of the specific customer and the identity of a plurality of selected products (see Smith column 5, lines 24-26; column 7, lines 55-62; column 8, lines 1-19); and

a computer facility capable of receiving the data signal and configured to determine if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products (see Smith column 8, lines 1-19),

*wherein the computer facility is configured such that the printed promotion carrier is presentable by the specific customer when used for each of the plurality of promotions for sale of the product (see Smith column 7, line 50 – column 8, line 10).*

Smith fails to teach:

wherein the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading device, and the computer facility determines if there are valid promotions contained on the promotion carrier, by determining if a promotion on the promotion carrier has already been presented in a completed transaction, and identifying the promotion as a valid promotion if it has not already been presented in a completed transaction. However, Day teaches detecting and avoiding double couponing (see column 6, line 55 – column 7, line 10). Therefore, it would have been obvious to a person of ordinary skill

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in the art at the time the application was made, to identify promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once).

As per claims 41 and 48, Smith teaches:

The system of claim 40, wherein the machine readable code is a bar code and the reading device is a bar code reading device (see Smith figure 6).

As per claims 42 and 49, Smith teaches:

The system of claim 40, wherein the data signal contains a product data signal bearing information indicative of an identity of the plurality of selected products and the computer facility determines a purchase price of the selected products (see Smith column 3, lines 15-25; column 8, lines 1-20).

As per claims 45 and 52, Smith teaches:

The system of claim 42, further comprising a check out terminal associated with the reading device and configured to receive payment for the selected products, wherein the computer facility is configured to generate a subtotal purchase price for the selected products, subtract valid promotions from the subtotal purchase price to generate a customer bill, and provide the customer bill to the check out terminal (see Smith column 3, lines 17-25).

As per claims 46 and 53, Smith teaches:

The system of claim 40, wherein

when the computer facility receives the data signal bearing information indicative of the identity of the promotion carrier for a completed transaction, data regarding all

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products comprising the completed transaction are stored (see Smith column 8, lines 9-19);

the system further comprising a data analysis facility which is configured to analyze the data signal and the data regarding all products comprising the completed transaction to determine predetermined aspects of the use of the promotion carrier (see Smith column 8, lines 9-20) including identities of each product of the completed transaction and at least one of the total charged amount for the completed transaction exceeding a predetermined value (see Smith column 3, lines 17-22), each product of the completed transaction providing a profit exceeding a predetermined money amount and each product of the completed transaction providing a profit exceeding a predetermined percentage (see Smith column 8, lines 9-20; "purchase volume of a particular product"). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if Smith determines the purchase totals to reflect savings (see Smith column 3, lines 19-22) and identifies purchase volume of a particular product, then Smith would use said identification to determine promotions that are producing profits (i.e. profits exceeding a predetermined volume or percentage) and would adjust the targeting of said promotions to customers based upon said determination. Smith would determine products that are not selling (i.e. low volume) and would target incentives to customers to entice customers to purchase said low selling products.

***Response to Arguments***

6. Applicant's arguments filed 01/25/2006 have been fully considered but they are not persuasive. The Applicant argues that the limitation that "the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product" clearly delineates that the printed promotion carrier will be presented each time it is used for each of the plurality of promotions for sale of the (single) product (i.e. it is reusable). The Examiner answers that nowhere in Applicant's specification is taught the limitation of a "printed promotion carrier, which carries information corresponding to a plurality of promotions for a single product". The Applicant needs to point out to the Examiner where in the Applicant's specification said limitation is taught.

The Applicant argues that neither Smith nor Day teach if a detected promotion on the printed promotion carrier has already been presented, and the promotion is identified as a valid promotion if it has not already been presented. The Examiner answers that the Applicant needs to point out to the Examiner where in the Applicant's specification said limitation is recited. Furthermore, the fact the Smith cancels the document so that it can not be used a second time suggest identifying a promotion as valid if it has not already been presented, as a cancel promotion carrier would be identified as not valid.



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***Conclusion***

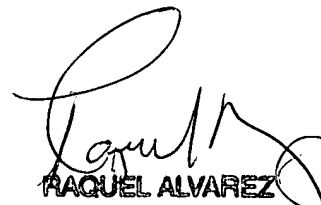
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
March 25, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER